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# In The
# Supreme Court of the United States
## October Term, 1994

CPC INTERNATIONAL INC.,
*Petitioner,*

*v.*

ARCHER DANIELS MIDLAND COMPANY,
*Respondent.*

On Petition for a Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

*Of Counsel:*

N. RICHARD POWERS
JOHN D. FAIRCHILD
PATRICIA ROGOWSKI
CONNOLLY, BOVE, LODGE & HUTZ
P.O. Box 2207
Wilmington, DE 19899-2207
(302) 658-9141

CHARLES A. LAFF *
MARTIN L. STERN
KEVIN C. TROCK
LAFF, WHITESEL, CONTE & SARET
401 N. Michigan Ave.
Suite 1700
Chicago, IL 60611
(312) 661-2100

* *Counsel of Record*

*Attorneys for Respondent*

Chicago Legal Copies, Inc. (312) 332-7777

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## QUESTIONS PRESENTED

Respondent Archer Daniels Midland Company ("ADM") disagrees with the two questions presented in the petition for writ of certiorari of CPC International Inc. ("CPC") in the following respects.

CPC's first question is inaccurate and misleading because it incorrectly assumes that the undisclosed information which represents the best mode of practicing the claimed invention was "developed subsequent to the invention." As the district court found, the undisclosed information was not developed subsequent to the claimed invention, but was a critical part of the claimed invention which CPC relied upon to distinguish the invention from the prior art and to obtain the patent in suit.

CPC's second question is also inaccurate because it incorrectly assumes that the district court's decision is inconsistent with prior holdings of the

Federal Circuit regarding the best mode requirement of 35 U.S.C. § 112 (1988). CPC fails to cite a single case from the Federal Circuit contrary to the decision of the district court in this case. CPC tries to create a conflict with prior Federal Circuit law by ignoring the most critical facts found by the district court, rearguing the case without regard to the undisputed evidence of record, and improperly relying on Fifth Circuit law which has no precedential authority on issues of substantive patent law. The Federal Circuit has exclusive jurisdiction of an appeal from a final decision of a district court of any civil action arising under the Patent Act. 28 U.S.C. §§ 1295, 1338 (1988).

## PARTIES TO THE PROCEEDINGS

Respondent is Archer Daniels Midland Company. Pursuant to Supreme Court Rule 29.1, respondent states that it has no parent company and that its only subsidiary (other than wholly-owned subsidiaries) is OEL MUE HLE Hamburg A.G.

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# *In the Supreme Court of the United States*
# *October Term, 1994*

CPC International Inc.,
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-v.-
Archer Daniels Midland Company,
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On Petition for a Writ of Certiorari to the
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for the Federal Circuit

## RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondent, ADM, respectfully opposes petitioner's request that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit, entered in this proceeding on July 11, 1994, affirming the judgment of the United States District Court for the District of Delaware.

## STATEMENT OF THE CASE

In its statement of the case, CPC ignores the district court's findings of fact and the uncontroverted evidence of record on material points which undermine its positions. CPC makes sweeping unsupported statements in an effort to recast the district court's decision to fit the issues it has presented. CPC's contrived issues have no application to the facts of this case.

CPC characterizes the critical development work of Swenson Processing Equipment Company ("Swenson") as merely a "commercialization study" conducted after the invention of U.S. Patent No. 4,357,112 (the "Edwards Patent") was made. In reality, the Swenson work consitutes the essence of the claimed invention of the Edwards patent.

App. 38a-41a.[1] As the district court found, when the Edwards patent application was rejected by the Patent and Trademark Office, CPC relied on the Swenson work as the sole basis "to demonstrate that the invention was not obvious" and to obtain allowance of the Edwards patent. App. 41a.

Indeed, Edwards knew that the conclusions he derived from his laboratory work as originally set forth in his patent application had been reversed and that none of his work was the basis for the claimed invention (A895-98; A2852). None of the supporting information and data were disclosed in the patent application and Edwards questioned the support for the changes to his patent application (A765-72;

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[1]The following abbreviations are used:

App.: Appendix to petition for writ of certiorari.

A: Appendix filed with the Federal Circuit Court of Appeals.

A895-98). Nonetheless, he signed the patent application as the sole inventor.

Thus, CPC's argument that "this case presents a straightforward . . . question of statutory interpretation" is based on the false premises that the Swenson work "was not part of the invention" and that Edwards did not know that the claimed invention was based on the work of another person instead of his own work.

Because this case turns on important facts which CPC does not include in its statement of the case, ADM presents the following statement which fully supports the district court's decision and affirmance by the Federal Circuit.

**The Edwards Test Work**

Food processors and soft drink manufacturers often sweeten their products with a type of sugar called glucose, which is also known as monohydrate dextrose as referred to in the Edwards patent. App. 4a.

The dextrose is used in crystalline form. App. 4a.

In January 1975, Larry W. Edwards, then a CPC engineer, began a study on the kinetics of monohydrate dextrose crystallization in connection with a CPC program to replace its commercial crystallizers. App. 8a-10a. Edwards wanted to determine the effect of the rate of agitation on the crystallization of monohydrate dextrose. App. 10a-12a. (A731-32). Edwards determined from his laboratory work that dextrose crystallization should be operated at agitator speeds of *no greater than* 60 cm/sec and concluded in his test report that:

> It would not be desirable to operate at tip speeds greater than about 60 cm/sec. because of the continuing increase with tip speed of the nucleation rate and the resulting adverse effect on crystal size distribution.

App. 11a-12a.

Edwards' conclusion not to exceed agitator speeds of 60 cm/sec was the result

of his stated goal to find the optimal agitation speed for the continuous crystallization of monohydrate dextrose and was the central premise for the crystallization process that he thought he had developed in reaching his goal (A737; A758; A735; A756; A791-92; A808-11; A816-20; A823-26; A899; A2416; A2458).

**The Swenson Pilot-Plant Work**

Edwards' work was put on the shelf in CPC's "Inactive Ideas" file until about 1979 when CPC was investigating modernization of its batch crystallization process at its North Kansas City facility. App. 12a, 38a, 40a. (A760; A5896-97; A2452-72). At that time CPC contacted Swenson to conduct pilot-plant studies because CPC needed additional "data regarding the effects of agitator type, size, and tip speed on the crystallization rate and crystal size" along with "a clearer definition of the process parameters" before CPC could practice the continuous

crystallization of monohydrate dextrose commercially (A960-61; A968; A2491-92). CPC provided Swenson with six separate studies of CPC's past work in the field, including Edwards' report of his studies (A941-43; A2499-2500).

At the outset, Swenson rejected Edwards' conclusion not to operate above 60 cm/sec and selected the equipment and crystallization process parameters to be used in the pilot-plant studies. The actual agitator speeds used in the Swenson studies were 516, 548 and 558 cm/sec. App. 12a. (A979-81; A5842; A4133; A4041-42; A2656-72).

**The Edwards Patent**

Edwards' concept for the continuous crystallization of monohydrate dextrose at agitator speeds not exceeding 60 cm/sec formed the basis for the original draft of Edwards' patent application. In fact, Edwards' conclusion that agitator tip speeds should not exceed 60 cm/sec *was included*

*verbatim* in the first draft of his patent application (A899-900; A2800; A2810; A2458; A764).

However, Erwin Froehlich, one of the CPC engineers involved with the Swenson work, revised the first draft of Edwards' patent application to reverse Edwards' concept not to exceed an agitator speed of 60 cm/sec (A6257-58; A2815).[2] On reading the first draft of Edwards' patent application, Froehlich commented that Edwards' conclusion not to exceed an agitator speed of 60 cm/sec made it sound like the Swenson work at speeds in the range of 500-600 cm/sec was "completely undesirable" (A6257-58; A2815). Accordingly, Froehlich had Edwards' patent application reworded to *delete* Edwards' conclusion not to exceed an agitation speed of 60 cm/sec and to claim as part of the

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[2]Peter Carrell, another CPC engineer at the time, was also involved with Froehlich in the Swenson work and the preparation of Edwards' patent application. App. 12a.

invention higher ranges of agitation speeds from 60-600 cm/sec (claim 1) and 300-600 cm/sec (claim 5) in light of the Swenson work (A6257-58; A2815). This changed the very essence of the claimed invention.

Thus, the crystallization process claimed in Edwards' patent was based upon the Swenson pilot-plant work, not on Edwards' laboratory work. Yet, none of the data from the Swenson work was included in the Edwards patent. App. 39a, 41a. The only example of the claimed crystallization process disclosed in the Edwards patent was Edwards' rejected laboratory work. App. 39a. And, contrary to CPC's assertion, Edwards' laboratory work was only disclosed in part so that one skilled in the art would not be able to confirm the accuracy of Edwards' work (A850-60; A1283-89; A806-07; A1387; A1445-48). Significant experimentation would have been required to practice the claimed invention at a commercial scale. App. 40a.

Edwards admitted that he knew additional work had been conducted (although he did not know that it was Swenson who conducted the work) (A2852), and that none of his work was the basis for claiming in his patent agitator speeds of 60 to 600 cm/sec (A895-98). The supporting data for the higher speeds was not disclosed in the patent application and Edwards questioned the new, higher agitator speeds because he recognized that the new speeds were not based on his work. (A2852). But he nonetheless agreed to change his patent application based on Swenson's work, agreed to change the claims to embody the Swenson work, and signed the oath declaring that he was the sole inventor (A765-72).

**Proceedings Below**

Relying on *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1535 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987), the district court held that "CPC intentionally failed to disclose what it knew at the time

was the best mode." App. 38a - 40a. This holding is also consistent with the Federal Circuit's more recent best mode decision in *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990).

Rejecting CPC's claim that the Swenson work was nothing more than routine scale-up work, the district court found that, "[i]n preparing the [Edwards] application, CPC stretched and redefined Edward's (sic) definition of his invention to cover what CPC learned in the [Swenson] scale-up." App. 41a. In fact, contrary to CPC's attempt to diminish the significance of the Swenson work, the district court found that the Swenson work revealed Edwards' error in concluding "that 60 cm/sec was a maximum appropriate tip speed," demonstrated "how Edwards' invention could be implemented," and provided the basis for CPC "to demonstrate that the invention was not obvious." App.

40a-41a. It was CPC's work with Swenson that prompted the filing of Edwards' patent application. App. 41a. In short, as the district court summed up, "the Swenson work was simply too important to ignore." App. A41a.

The Federal Circuit affirmed without an opinion under its Circuit Rule 36 because the district court's decision is based on findings that are not clearly erroneous and follows the law as set forth in *Spectra Physics* and *Northern Telecom*. An opinion by the Federal Circuit would have no precedential value in light of the very fact-specific circumstances from which the best mode issue arose in the present case.

## SUMMARY OF ARGUMENT

1. The petition improperly reargues the facts of this case as found by the district court and affirmed by the Federal Circuit and fails to establish any important legal issues that would have significance

beyond the facts of this case and which should be decided by the Supreme Court.

2. The Federal Circuit has exclusive jurisdiction over substantive issues of patent law, such as the issues raised by petitioner regarding 35 U.S.C. § 112 (1988). The decision by the district court and affirmance by the Federal Circuit is supported by substantial evidence and is consistent with Section 112 and prior precedent of the Federal Circuit interpreting Section 112. The decisions by the lower courts in this case are not in conflict with the decision of any other United States court of appeals.

## REASONS FOR DENYING THE WRIT

### I. THE QUESTIONS RAISED HAVE NO SIGNIFICANCE BEYOND THIS CASE

CPC conveys the impression that its arguments raise legal issues that have important implications beyond this case, but fails to show how. The specific facts here limit any impact this case may have on other

best mode cases, thereby warranting the Federal Circuit affirmance of the district court's decision without opinion.

Thus, this case does not fit the "common situation" CPC describes in its petition at pages 8 to 9. Unlike such "common situations," in the present case the Swenson work which was not disclosed in Edwards' patent formed the very basis for the claimed invention and provided CPC with the grounds to distinguish the patented invention from the prior art and obtain allowance of the patent. App. 41a. This is not a case where a corporate assignee conducts additional commercialization work after an invention is made in order to bring the invention to the market. To the contrary, the Swenson work is at the heart of the claimed invention. Edwards' original concept not to exceed an agitation rate of 60 cm/sec as included in the first draft of his patent application was rejected based on the Swenson work, and the

patent claims were redrafted to specifically cover the Swenson work (A6257-58; A2815).

Contrary to CPC's argument, this case does not mean that patent applicants must "search out and set forth all" work done by a corporate assignee in commercially implementing an inventor's discovery or risk later invalidation of the patent. The undisclosed Swenson work showed that Edwards' conclusion from his laboratory work was wrong and the Swenson work became the essence of the invention claimed in Edwards' patent. Under such circumstances, where an invention is changed to incorporate and claim another person's work (*i.e.* the Swenson work), there is a duty under Section 112 to disclose such work in the patent specification. 35 U.S.C. § 112 (1988). This requirement was expressly recognized by the Federal Circuit during oral argument when the court stated that once the claimed invention is changed from what the inventor had originally invented, there is a

duty to disclose those claimed changes in the specification. Trans. of Oral Argument July 7, 1994 at page 11. This does not mean, as CPC contends, that additional work which is not part of the claimed invention must be disclosed in the patent.

The decision in this case does not affect inventive work carried on by large corporations where different individuals or departments work on the same subject matter without the other's knowledge. The duty to disclose the best mode under this case only extends to those individuals, such as the inventor Edwards and CPC engineers Froehlich and Carrell, who actually worked on the patent application.

CPC's petition amounts to no more than a reargument of the facts of the case. That CPC's arguments primarily raise factual questions is not surprising since the "best mode" inquiry is a question of fact which must be considered upon a "clearly erroneous"

standard of review. *Chemcast Corp. v. Arco Indus. Corp.*, 913 F.2d 923, 928 (Fed. Cir. 1990). This case does not raise any legal issues which warrant consideration by the Supreme Court.

## II. THE LOWER COURTS' DECISIONS DO NOT CONFLICT WITH ANY PRIOR DECISIONS UNDER SECTION 112

Neither the district court's decision nor the Federal Circuit's affirmance marks any departure from settled law, including *Texas Instruments Inc. v. United States International Trade Commission*, 871 F.2d 1054 (Fed. Cir. 1989), upon which CPC relies. The facts of the present case are readily distinguishable from *Texas Instruments* and nothing in the district court's decision is inconsistent with the law as stated in *Texas Instruments*. In the present case the Federal Circuit reaffirmed that an inventor and his agents who work on the patent application must disclose the best mode known to them of practicing the claimed invention.

*Texas Instruments* does not even address the issues raised here by CPC. In *Texas Instruments*, the alleged infringer Samsung asserted that the best mode for "boosting the wordline voltage" was not disclosed in the specification of the patent in suit. *Texas Instruments*, 871 F.2d at 1061. Samsung's defense was rejected because, unlike the present case, Samsung admitted that "the inventors themselves did not consider the 'word boost' feature to be part of the best mode of their invention." *Id.* There, the record failed to disclose that the applicant knew of or concealed a better mode than he disclosed and the Court of Appeals found this to be supported by substantial evidence. *Id.* Here, the district court found that the best mode was *deliberately concealed* and this was supported by substantial evidence. App. 40a.

Moreover, unlike *Texas Instruments*, in the present case, the undisclosed Swenson work represents the best mode and was used to

redefine the claimed invention. App. 41a. Edwards knew that the claimed process of his patent was based on the undisclosed work of others (Swenson), and he himself questioned the absence of such work from the patent application (A2852, A895-98). He also knew that the claims had been changed to redefine the invention to include such undisclosed work and to change the conclusions he reached from his laboratory work. Thus, the inventor Edwards knew the best mode was not disclosed in his patent.

CPC's attempt to rely on *Studiengesellschaft Kohle v. Eastman Kodak Co.*, 616 F.2d 1315 (5th Cir.), *cert. denied*, 449 U.S. 1014 (1980), is misleading, at best. As CPC well knows, *Kohle* has no precedential authority on issues of substantive patent law, such as the best mode requirement of 35 U.S.C. § 112 (1988). *Federal Courts Improvement Act of 1982*, .Publ. L. No. 97-164, 96 Stat. 25 (codified in part at 28 U.S.C. §§

171-177, 1295 (1988); *Titanium Metals Corp. Of America v. Banner*, 778 F.2d 775, 779 (Fed. Cir. 1985); *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982).

In any event, *Kohle* is readily distinguishable from the present case. In *Kohle*, a patent covering certain chemical catalysts useful in the polymerization of hydrocarbons was at issue. The best mode issue concerned whether certain modifications made to the process by someone other than the inventor, and about which the inventor knew at the time of the patent application, should have been disclosed as the best mode of practicing the claimed invention. The court found that there had been no violation of the best mode requirement because there was no evidence that such modifications were actually the best mode of carrying out the claimed process. *Kohle*, 616 F.2d at 1340. In contrast, as the district court found, the Swenson work represents the best mode of

practicing Edwards' patent. App. 39a-41a. And Edwards knew that the claims of his patent had been rewritten to cover someone else's work, which he specifically questioned. (A895-98; A2852).

The decision in this case is consistent with Federal Circuit precedent such as *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 940 (Fed. Cir.), *cert. denied*, 498 U.S. 920 (1990), and *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1537 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987), which show that the actions and knowledge of CPC (i.e. its employees Froehlich and Carrell involved in preparing the Edwards patent application) must be considered with respect to CPC's intentional concealment of the best mode. *See also* 2 Chisum, *Patents* § 7.05[1], at 7-120 (1992) (assignee with right to apply for patent must disclose best mode). In *Northern Telecom*, the court relied on the knowledge of the

assignee finding "that Sycor [the assignee] concealed the best mode of carrying out the invention of these claims" and that "Sycor knew, in advance of filing the patent application, that standard audio tape was not the best mode for carrying out the invention." *Northern Telecom*, 908 F.2d at 940. It was the knowledge of a former Sycor employee who was not an inventor and other activity by the corporation which supported the district court's holding that the best mode had not been disclosed. *Northern Telecom*, 908 F.2d at 940.

Likewise, in *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1537 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987); the Federal Circuit held the patent invalid under 35 U.S.C. § 112 (1988) because:

> Coherent [the assignee] did not disclose *any* details about its brazing process. It is this complete lack of detail which effectively resulted in its concealment. (Emphasis in original.)

The district court's decision that Edwards' patent is invalid for failure to disclose the best mode, and the Federal Circuit's affirmance, do not raise any precedent-setting issues. The holding is fully supported by the evidence and applicable law.

## III. THE LOWER COURTS' DECISIONS ARE CONSISTENT WITH SECTION 112

CPC tries to create a legal issue regarding interpretation of the language of Section 112. This "issue," however, is based on the false premises that the Swenson work "was not part of the invention" and that Edwards did not know that the work of another person was included as part of the claimed invention in his patent.

To argue, as CPC does, that Edwards did not violate the best mode requirement when he knew that undisclosed work done by others formed the very basis for the claimed process -- a process that was the antithesis of his work -- finds no support in Section 112 or

any case cited by CPC. To accept CPC's argument and permit an inventor, like Edwards, *knowingly* to define and claim another's work as his invention without disclosing such work, where such work indisputably represents the best mode of practicing the claimed invention, would contravene Section 112. If an invention is changed to incorporate and claim another person's work, there is a duty to describe in the patent specification that other work.

Because the changes to Edwards' patent application based on Swenson's work altered the very essence of the claimed invention, Edwards' duty of candor and good faith required that he investigate the basis for the changes made to his patent application, particularly because such changes reversed his own conclusion not to exceed an agitator speed of 60 cm/sec. 37 C.F.R. § 1.56(a). The Federal Circuit expressly recognized this obligation when the court stated at oral

argument that changing the essence of the claimed invention imposed a duty on the inventor to disclose the best mode as required under the statute. Trans. of Oral Argument July 7, 1994 at pages 13-14.

Furthermore, apart from Edwards' knowledge of the Swenson work, CPC employees Froehlich and Carrell actively participated in the preparation of Edwards' patent application and were directly involved with the Swenson work (A939; A953-54; A960-61; A964-69; A987; A2491-92; A2814-22; A5838; A5856-59; A6287-89). It was CPC's Froehlich who rewrote the patent application based on the Swenson work to reject Edwards' conclusion not to exceed an agitator speed of 60 cm/sec and instead to claim the agitation speeds developed by Swenson (A2814-15; A6257-58). Thus, Froehlich, Carrell, and the others at CPC working on the patent application, also had a duty of candor and

good faith under 37 C.F.R. § 1.56(a) to disclose the best mode (A4612, A953-54).

The duty of good faith and candor under 37 C.F.R. § 1.56(a) applies to the best mode requirement of Section 112 and extends to all those associated with Edwards and CPC who participated in the preparation of the Edwards patent application. To accept CPC's argument would not only contravene the best mode requirement of 35 U.S.C. § 112, but also the duty of candor and good faith under 37 C.F.R. § 1.56(a).

In addition to failing to disclose the best mode, CPC also misleadingly presented Edwards' laboratory work as the sole example of the claimed process, thereby preventing a person skilled in the art from practicing the claimed invention.

CPC's deliberate concealment of the best mode violates Section 112, and the lower courts' decisions are consistent with the best mode requirement of Section 112.

## IV. THE FEDERAL CIRCUIT'S AFFIRMANCE UNDER ITS CIRCUIT RULE 36 WAS APPROPRIATE

All of the issues raised by CPC relate to factual questions unique to the present case and do not raise any precedent-setting issues of law. As ADM has shown, the central premise of CPC's petition is based on the false assertions that Swenson's work was not part of the claimed invention of the Edwards patent and that Edwards did not know that the claimed invention embodied another person's work. CPC also ignores the critical role that its engineers Froehlich and Carrell played in redrafting Edwards' patent application to reject Edwards' concept and claim the Swenson work.

The undisputed facts, which CPC seeks to reargue in its petition, overwhelmingly support the district court's decision of a best mode violation under 35 U.S.C. § 112 (1988) and the Federal Circuit's affirmance without opinion under its Federal Circuit

Rule 36. No "new rule" was adopted by the Federal Circuit in affirming the district court's decision and this case does not raise any issues of precedential value.

No uncertainty is created by the decisions of the lower courts in this case. If an inventor and those involved in preparing a patent application know that the claimed invention is based on the work of someone other than the inventor, and such work is the best mode of practicing the claimed invention, that other work must be disclosed under the requirements of Section 112.

## CONCLUSION

For the foregoing reasons, CPC's petition for writ of certiorari should be denied.

Charles A. Laff*
Martin L. Stern
Kevin C. Trock
Laff, Whitesel,
Conte & Saret, Ltd.
401 N. Michigan Ave.
Suite 1700
Chicago, IL 60611
(312) 661-2100

Attorneys For
Respondent

OF COUNSEL:

N. Richard Powers
John D. Fairchild
Patricia Rogowski
Connolly, Bove, Lodge & Hutz
P.O. Box 2207
Wilmington, DE 19899-2207
(302) 658-9141

* Counsel of Record

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